



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,884	09/23/2004	Atsushi Asai	450100-04443	8101

22852 7590 10/04/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER
----------

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/508,884	<b>Applicant(s)</b> ASAI, ATSUSHI	
	<b>Examiner</b> Nathan Hillery	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                  |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                             | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/23/04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This action is responsive to communications: Application filed on 9/23/04.
2. Claims 1 – 26 are pending in the case.

### ***Priority***

3. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.
4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
5. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

### ***Information Disclosure Statement***

6. The information disclosure statement filed 9/23/04 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each publication listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

***Drawings***

7. Figures 1 – 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1, 5, 7 – 17, 20, 22 – 24 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 5, 7 – 17, 20, 22 – 24 and 26 are considered software per se. Computer programs may be explicitly claimed as, for example, a series of code or instructions for performing functions or may be implicitly claimed as, for example, a system, a module or an apparatus. Where there is no evidence in the specification that a means which may be interpreted as software, hardware or combinations thereof necessarily includes hardware, it will be interpreted in its broadest reasonable sense as a software means, which is the case here.

Thus a claim to functional descriptive material, including computer programs, per se, is not patent eligible subject matter. It should be noted that functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer system.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 – 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Core (Core Web3D).

**Regarding independent claim 1**, Core teaches that Sony Community Place Conductor is a multiuser authoring tool used to construct worlds that can be inhabited by more than one person at a time. Users must install the Sony Community Place VRML browser before they can step into such worlds. In addition, these worlds must be delivered by Sony's multiuser Community Place Bureau server (p 4, Multiuser (MU) World Builders, second block paragraph), which meet the limitation of **browser software for providing each component with a service in accordance with specifications to be satisfied in order for said each component to receive said service.**

Core teaches that World builders typically come with libraries of premade objects, texture maps, background images, and audio files that you can assemble into comprehensive worlds or use as the basis for your own objects. In addition, many world builders come with example scenes that you can use as a starting point for your own worlds (p 1, World Builders, second block paragraph), which meet the limitation of a **multimedia content formed by a collection of scenes each containing a component group formed by customizing and arbitrarily combining a plurality of said components operating on said browser software and a script for operating said component.**

Core teaches that you can use world builders to assemble preexisting VRML objects into scenes where you can then add hyperlinks, lights, and viewpoints. World builders also allow you to visually customize existing VRML content for your own needs (p 1, World Builders, first block paragraph); and Core teaches that these tools can also be used to create VRML models for use with Java 3D, MPEG-4/ BIFS, and X3D (p 1, Visual Development Tools, fourth block paragraph), which meet the limitation of a **service for reading a predetermined one of said multimedia content and loading said component group and said script contained in said scene constituting said multimedia content.**

Core teaches that World-builder tools are 3D authoring programs that you can use to create entire VRML scenes from scratch. You can use world builders to assemble preexisting VRML objects into scenes where you can then add hyperlinks, lights, and viewpoints. World builders also allow you to visually customize existing

VRML content for your own needs, and many actually offer integrated modeling tools with which you can construct your own objects (p 1, World Builders, first block paragraph), which meet the limitation of **a service for managing a life cycle of each component constituting said component group.**

Core teaches that like most modelers, Nendo offers a large number of modeling commands that can be applied to objects as they're developed. Entire objects (or selected portions of an object), can be copied, pasted, deleted, mirrored, flipped, inverted, extruded, scaled, smoothed, moved, rotated, and much, much more (p 7, first block paragraph), which meet the limitation of **a service for displaying said component in a predetermined 3D virtual space and erasing said component already displayed in said 3D virtual space.**

Core teaches that the blaxxun Contact browser already supports Universal Media, making it the first VRML browser of its kind (p 5, first two lines), which meet the limitation of **a service for providing a communication service between an interpreter of said script and said component**, since Universal Media means you can craft media-rich worlds that download over the network instantly (p 4, lines 3 – 5).

Core teaches that after assigning behavior components to the model you can visually "wire" together the various input and output fields they contain (see Figure 10-18). Wiring the camcorder's focus buttons to the LED display, allowing users to zoom in and out of the picture, provides additional functionality (p 11, lines 1 – 6), which meet the limitation of **a service for managing focus transition between a predetermined one of said components and another of said components.**

Core teaches that after assigning behavior components to the model you can visually "wire" together the various input and output fields they contain (see Figure 10-18). Wiring the camcorder's focus buttons to the LED display, allowing users to zoom in and out of the picture, provides additional functionality (p 11, lines 1 – 6), which meet the limitation of **a service for distributing an input from a predetermined external key to a corresponding one of said components.**

**Regarding dependent claim 2,** Core teaches that after assigning behavior components to the model you can visually "wire" together the various input and output fields they contain (see Figure 10-18). Wiring the camcorder's focus buttons to the LED display allows users to zoom in and out of the picture. Behaviors have been assigned to the viewfinder and LED display of the model (see Figure 10-19) (p 11, lines 1 – 6), which meet the limitation of **a service for synchronously reproducing a plurality of media; and a transition service for transition between first and second ones of said scenes.**

**Regarding dependent claim 3,** Core teaches that the blaxxun Contact browser already supports Universal Media, making it the first VRML browser of its kind (p 5, first two lines), which meet the limitation of **multimedia content is configured to maintain presentation consistency when said multimedia content is reproduced on said browser software,** since Universal Media means you can craft media-rich worlds that download over the network instantly (p 4, lines 3 – 5).



**Regarding dependent claims 10, 14, and 23**, Core teaches that Figure 10-10. Internet Space Builder is an integrated world-building tool that supports geometric modeling, texture editing, and scene creation (p 2), which meet the limitation of **combining said produced multimedia content and said browser software to create one program.**

**Regarding dependent claim 11**, Core teaches that Internet Space Builder includes sophisticated texture-mapping and texture-editing tools, giving you great control over the appearance of texture maps used in your scenes. In addition, Internet Space Builder's multimedia capabilities allow you to map texture movies to objects and add MIDI and WAV file sound sources to scenes (p 1, World Builders, third paragraph), which meet the limitation of **a display control step of controlling to read said component in a distribution format and displaying on GUI.**

Core teaches that Figure 10-11. Internet Scene Assembler lets you assemble premade objects into interactive, dynamic worlds (pp 2 and 3), which meet the limitations of **an addition step of adding said component selected on said GUI to said multimedia content and a providing step of providing said GUI which customizes said component contained in said multimedia content.**

Core teaches that because Internet Space Builder doesn't support behavior modeling or event handling, the scenes you create with this world-building tool are static in nature. As a result, you must import the scenes you create with this tool into a

behavior-oriented authoring tool (p 3, first paragraph block), which meet the limitation of **a converting step of converting said multimedia content edited by said display control step, said addition step and said providing step into a distributable format.**

**Regarding dependent claims 15 and 24,** Core teaches that X3DML is a language designed to integrate easily with other languages, to precisely describe the types of information needed for creating animated 3D worlds. X3DML is being designed to broaden the tools available to authors and to ensure that what they create will last by putting that information into a form that is used by more tools, more implementers, and more authors (p 15, last block paragraph), which meet the limitation of **said techniques of being utilized by said first format are techniques utilizing XML.**

**Regarding dependent claim 18,** Core teaches that Sony Community Place Conductor is a multiuser authoring tool used to construct worlds that can be inhabited by more than one person at a time. Users must install the Sony Community Place VRML browser before they can step into such worlds. In addition, these worlds must be delivered by Sony's multiuser Community Place Bureau server (p 4, Multiuser (MU) World Builders, second block paragraph), which meet the limitation of **storing means for storing said browser software, said storing means storing said browser software in advance; wherein said executing means executes said browser**

Art Unit: 2176

**software stored in advance in said storing means, if said multimedia content is acquired by said acquiring means.**

**Regarding independent claims 4 – 9, 12, 13, 16, 17, 19 – 22, 25 and 26, the claims incorporate substantially similar subject matter as claim 1 and are rejected along the same rationale.**

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NH



**Doug Hutton**  
**Primary Examiner**  
**Technology Center 2100**